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10/821,697

04/09/2004

Robert P. Bishop

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EXAMINER

DREIDAME, HUNTER M

ART UNIT

PAPER NUMBER

3633

MAIL DATE

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12/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/821,697

**Applicant(s)**

BISHOP, ROBERT P.

**Examiner**

Hunter M. Dreidame

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,9 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In view of applicant's amendment received 13 July 2007, Applicant's Remarks have been carefully considered but are not deemed persuasive to overcome the rejections of the previous office action. Therefore, the rejection of claims 1, 2, 4, 6, 7, 8, and 10-15 has been reiterated in this Office Action.

#### ***Drawings***

The drawings are objected to because the crossed-out reference numerals (30, Fig. 2F) and initials make the drawing appear informal. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

Claims 1 and 10 are objected to because of the following informalities:

Claim 1 recites the limitation "the aperture" in lines 6 and 7. There is insufficient antecedent basis for this limitation in the claim;

Claims 1 and 10 recite the limitation "the aperture head" in lines 10 and 1, respectively. There is insufficient antecedent basis for this limitation in the claim;

Claim 1, line 10, should be amended to –a pair of legs—from "a pair of leg".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 4, 6 - 8 and 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, 4, 6, 7, 8, 10, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2,096,648 to Place.**

**As to claim 1,** Place discloses a clip (11, Fig. 1) capable of securing objects at a top surface of a deck or the like, formed of an array of spaced apart, parallel elongated members (shown in Fig. 6) of substantially uniform thickness with sides of adjacent ones of the members substantially parallel to each other (shown in Fig. 6), the clip comprising an operative head (14, Fig. 1) formed by substantially contiguous length of material bent into aperture form (space between 15, 16, Fig. 1) and of hardness to resist distortion in installation and usage and adapted to be capable of receiving connectors to an object in the aperture formed thereby having a maximum aperture span dimension (shown in Fig. 7) greater than the spacing between the surface forming members in the space therebetween (shown in Fig. 6); a pair of legs (17, 18, Fig. 1) of said length of material extending from the aperture head, the legs each dimensioned to fit in the spacing between the surface forming members and to traverse the thickness of adjacent ones of the surface members in the space therebetween (shown in Fig. 6); and a pair of feet (19, 20, Fig. 1) with one foot extending from each one of the pair of legs, the feet diverging from the thickness traversing direction of the legs in opposite directions to span a distance greater than the spacing between the surface members (shown in Fig. 6), the feet being constructed and arranged to lie flat against undersides

of the adjacent members after the clip is passed through the said space between said members in a first orientation, and the clip is rotated to a second orientation.

The clip of Place is capable of performing the functions suggested in claim 1, as only the structure of the clip is being claimed, not the combination including the surface of a deck or the like. Therefore, one could insert the clip of Place between two parallel members in one orientation, then rotate the clip into a second orientation.

**As to claim 2**, Place discloses that the legs are substantially co-planar with the head (shown in Fig.1).

**As to claim 4**, Place discloses that the clip is of wire or wire-like (lines 51-56, col. 5) and the feet are substantially coplanar with the head (shown in Fig. 1).

**As to claim 6**, Place discloses that the head, the pair of legs and the pair of feet thereof are formed as a single element (shown in Fig. 1).

**As to claim 7**, Place discloses the clip of claim 6, wherein the single element comprises a wire (lines 51 – 56, col. 5).

**As to claim 8**, Place discloses that the legs are spring-loaded to separate from one another so as to engage an opposing surface member (shown in Fig. 7).

**As to claim 10**, Place discloses that the aperture head is formed in a shape selected from the group consisting of rings, ellipsoids, and multi-sided shapes (multi-sided shape as shown in Fig. 1).

**As to claim 13**, Place discloses that the clip is composed of spring-tempered material (lines 3 – 8, col. 3).

**As to claim 14**, Place discloses the clip of claim 13, wherein the legs are compressible to a position within the spacing between the surface members such that the feet diverge in separate planes substantially parallel to a plane including the head (Fig. 1).

**As to claim 15**, Place discloses that the feet diverge in substantially straight, diametrically opposed directions (shown in Fig. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 2,096,648 to Place in view of US Patent 6,893,025 to Hight, Jr. et al.**

**As to claim 11**, Place discloses to clip of claim 1, as discussed above. Place does not disclose that said material is composed of a high-strength, corrosion resistant material. Hight, Jr. et al. disclose a clip (Fig. 1) wherein the material is composed of a high-strength, corrosion resistant material (lines 30 – 33, col. 3). In view of Hight, Jr., et

al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have composed the clip of Place with the material of Hight, Jr., et al. as a means of further strengthening and providing greater longevity for the clip.

**As to claim 12**, Hight, Jr., et al. disclose the clip wherein the material is selected from the group consisting of stainless steel, brass, aluminum, and plastic (lines 30 – 33, col. 3, Hight, Jr., et al.).

### ***Response to Arguments***

Applicant's arguments filed 13 July 2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that the clip of Place is intended for use in securing moldings, rather than securing objects to the surface of a deck, Examiner asserts that the clip of Place is capable of the functions described in Claim 1. The clip of Place meets all structural limitations as recited and is capable of securing objects to a deck in that it's feet and may be passed through a space between two decking members, followed by orienting the clip in a second direction.

As to the Applicant's argument that the clip of Place does not comprise an operative head, Examiner respectfully disagrees. The head of Place is operative in that an object may be clipped to it, and, when the clip is engaged with a surface, the object cannot become unclipped.

The declaration under 37 CFR 1.132 filed 10/02/07 is insufficient to overcome the rejection of claims 1,2, 4, 6, 7 and 10-15 based upon Place as set forth in the last Office



action because: Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter M. Dreidame whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/821,697  
Art Unit: 3635

Page 9

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Hunter Dreidame, Patent Examiner  
December 13, 2007

Robert Canfield  
Primary Examiner

